REMARKS

This Amendment responds to the Office Action dated October 19, 2010 in which the Examiner rejected claims 10-18, 20-21, 28-29 and 34-36 under 35 U.S.C. § 103.

As indicated above, a typographical error in claim 1 has been corrected. Applicant respectfully requests the Examiner approves the correction.

As indicated above, claims 10, 18, 20-21, 28-29 and 36 have been amended in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability.

Claims 10-16, 18, 20-21, 28-29 and 34-36 were rejected under 35 U.S.C. § 103 as being unpatentable over *Bar-El* (WO 99/26415) in view of *Srinivasan, et al.* (U.S. Publication No. 2001/0023436) and *Zigmond, et al.* (U.S. Patent No. 6,698,020).

Bar-El appears to disclose in Figure 1 a personalization system 10 operates on a video server 11 and communicates with a multiplicity of user computers or clients 12 via a network (page 7, lines 11-15). As shown in Figure 2, the personalization system 10 comprises a user identifier 20, a user database 21, an object storage unit 22, a video controller 24, a video analyzer 25 and a plurality of video personalization modules 26, one per user currently receiving a video stream (page 9, line 22-page 10, line 2). Object storage unit 22 and video controller 24 both provide their output to the personalization module 26 associated with the user. The object storage unit 22 outputs the personalized data, such as a set of advertisements, associated with the user's group and the names associated with each image to be implanted and video controller 24 provides the selected video and the associated video parameters describing how to transform the personalized data in order to implant the personalized data into the video stream (page 12, lines 3-9). Personalization module 26 uses each transformation T to transform, per frame, the flat

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images 39 of the personalized data into perspective images 41 whose perspective matches that of the surface on which the images are to be implanted. The personalization module 26 then implants the perspective images 41 into the background of the current frame, thereby producing a personalized frame which is transmitted to the user's computer 12 (page 13, line 23-page14, line 4).

Thus, *Bar-El* only discloses implanting images into the background of a current frame to produce a personalized frame. Nothing in *Bar-El* shows, teaches or suggests inserting an advertising image at a position where a scene is changed as claimed in claims 10, 18, 20, 21, 28-29 and 36. Rather, *Bar-El* only discloses implanting an image into the background of a current frame.

Furthermore, since *Bar-El* only discloses implanting an image into the background of a current frame, nothing in *Bar-El* shows, teaches or suggests (1) an image content providing method of providing image content by download distribution and package distribution as claimed in claim 10, (2) an image content providing system, apparatus and storage medium providing image content and advertising image via a stream distribution, deputy stream distribution and multicast stream distribution as claimed in claims 18, 20 and 28, (3) an advertisement image selecting means communicating with an image content providing apparatus and an image reproducing apparatus and receiving selection information from the image content producing apparatus or image reproduction apparatus in order to select an advertisement image as claimed in claims 21 and 29 and (4) when the image is provided by stream distribution, the image program providing apparatus provides the image and advertisement image directly to the image program reproducing apparatus, when the image is provided by deputy stream distribution, the image program providing apparatus instructs a plurality of deputy stream program providing

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apparatuses to distribute the image and the advertisement image to the image program reproducing apparatus and when the image is reproduced by multicast stream distribution, the image program providing apparatus distributes the image to a plurality of distribution splitter nodes and the splitter nodes acquire the advertisement image and distribute the image and advertisement image to the image program reproducing apparatus as claimed in claim 36.

Srinivasan, et al. appears to diselose a video-on demand system where a user orders a particular stored video presentation to be sent at a particular time, ads may be selected and inserted at any convenient time prior to sending to the user [0202]. When a subscriber orders a video presentation, the ad server notes the client ID matches the ID with the user profile, consults a dynamic ad schedule and determines the ads to be inserted. The ad server controls and pulls both the video presentation and the ads to be inserted from data storage, controls the data streams at the ad server to start and stop each video stream at the appropriate time to place the ads, and so forth [0204]. In an alternative embodiment, the ad server does not insert ads into the video stream but instead stores URLs internet addresses (for ads). The ad engine retrieves the needed URLs for the ads to be inserted, and inserts them in the video stream as metadata [0205]. The playback unit at the client station 205 makes use of the inserted metadata to pull the relevant ads or ads from the appropriate destinations in the internet [0206].

Thus, Srinivasan, et al. only discloses a video on demand system in which ads are selected and inserted prior to sending to a user. Nothing in Srinivasan, et al. shows, teaches or suggests detecting a position of inserting an advertisement image which is a position where a scene is changed as claimed in claims 10, 18, 20-21, 28-29 and 36. Rather, Srinivasan, et al. only discloses a video on demand system. Furthermore, Srinivasan, et al. does not show, teach or suggest the other features as discussed above.

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Zigmond, et al. appears to disclose a conventional video programming feed displayed to a viewer. Either before or during the display of the video programming feed to the viewer, a plurality of advertisements from an advertisement source are received by a home entertainment system in the household. The received advertisements are either stored in an advertisement repository for later display or are made available to the home entertainment display at an appropriate time for immediate display (column 4, lines 15-24). Statistics collection location 61 counts the number of times a particular viewer has seen a selected advertisement. Once the advertisement has been displayed the desired number of times during a given time period, further display of the advertisement to the viewer is blocked (eolumn 13, lines 40-45).

Thus, *Zigmond, et al.* merely discloses that once an ad has been displayed a desired number of times, the advertisement is blocked to the viewer. Thus, nothing in *Zigmond, et al.* shows, teaches or suggests detecting a position of inserting an advertising image which is a position where a scene is changed as claimed in claims 10, 18, 20-21, 28-29 and 36. Furthermore, *Zigmond, et al.* does not show, teach or suggest the other features as discussed above with regard to claims 10, 18, 20-21, 28-29 and 36. Rather, *Zigmond, et al.* only discloses blocking an advertisement after being played a desired number of times.

The Examiner takes official notice that it is well known in the art to provide a title list. Even assuming arguendo that a title list is known, nothing in the Official Notice shows, teaches or suggests the primary features as discussed above for claims 10, 18, 20-21, 28-29 and 36.

A combination of *Bar-El*, *Srinivasan, et al.* and *Zigmond, et al.* would merely disclose to implant an image into the baekground of a current frame as taught by *Bar-El*, to have a video on demand system on which ads or URL's are plaeed into a video stream as taught by *Srinivasan, et al.* and to only display ads a desired number of times as taught by *Zigmond, et al.* Thus, nothing

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in the combination of the references shows, teaches or suggests detecting a position of inserting an advertisement image in the image content where the position of inserting the advertisement is a position where a scene is changed as claimed in claims 10, 18, 20-21, 28-29 and 36. Furthermore, nothing in the combination of the references shows, teaches or suggests (a) a download distribution method and package distribution method as claimed in claim 10, (b) providing image content and advertisement image to a reproduction apparatus via stream distribution, deputy stream distribution and multicast distribution as claimed in claims 18, 20 and 28, (c) an advertisement image selecting means communicating with an image content providing apparatus and image reproducing apparatus, receiving selection information there from and providing the selected advertisement image to the image content providing apparatus or image reproducing apparatus that provided the selecting information as claimed in claims 21 and 29 or (d) the various ways of communicating by stream distribution, deputy stream distribution and multicast distribution as claimed in claim 36. Therefore, Applicant respectfully requests the Examiner withdraws the rejection to claims 10, 18, 20-21, 28-29 and 36 under 35 U.S.C. § 103.

Claims 11-16 and 34-35 recite additional features. Applicant respectfully submits that claims 11-16 and 34-35 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Bar-El*, *Srinivasan, et al.* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore, Applicant respectfully requests the Examiner withdraws the rejection to claims 11-16 and 34-35 under 35 U.S.C. § 103.

Claim 17 was rejected under 35 U.S.C. § 103 as being unpatentable over *Bar-El*, *Srinivasan, et al.* and *Zigmond, et al.* and further in view of *Hite, et al.* (U.S. Patent No. 5,774,170).

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Applicant respectfully traverses the Examiner's rejection of the claim under 35 U.S.C. § 103. The claim has been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicant respectfully requests the Examiner withdraws the rejection to the claim and allows the claim to issue.

As discussed above, since nothing in *Bar-El*, *Srinivasan, et al.* and *Zigmond, et al.* show, teach or suggest the primary features as claimed in claim 10, Applicant respectfully submits that the combination of the primary references with the secondary reference to *Hite, et al.* would not overcome the deficiencies of the primary references. Therefore, Applicant respectfully requests the Examiner withdraws the rejection to claim 17 under 35 U.S.C. § 103.

Since claims 1-9, 19, 22, 30, 32-33 and 37 have not been rejected, Applicant respectfully submits that these claims are in condition for allowance.

Thus, it now appears that the application is in condition for reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested. Should the Examiner find that the application is not now in condition for allowance, Applicant respectfully requests the Examiner enters this Amendment for purposes of appeal.

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CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicant respectfully petitions for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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Date: December 13, 2010

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